

REMARKS/ARGUMENTS

I. General Remarks and Remarks Regarding the Restriction Requirement.

Applicants respectfully request that the above amendments be entered and further request reconsideration of the application in view of the amendments and the remarks contained herein.

II. Disposition of the Claims.

At the time of the Office Action, claims 1-36 were pending. Claims 1, 2, 4-7, 9, 10, 12, 13, 15-18, 20, 21, 23-27, 30, 32-34 and 36 stand rejected. Claims 3, 8, 11, 14, 19, 22, 28, 29, 31, and 35 have been objected to. Applicants have not included a listing of claims in this Response because Applicants have not made any claim amendments herein. *See Manual of Patent Examining Procedure* § 714(II)(C) (2004) (hereinafter "MPEP")

III. Remarks Regarding Objections to the Abstract and Specification.

The Examiner has objected to the Abstract "because the abstract includes the implied phrase 'The present invention is disclosed to'." (Office Action at 2.) Applicants have amended the Abstract in accordance with the Examiner's request. Accordingly, Applicants respectfully request withdrawal of this objection with respect to the Abstract.

The Examiner has objected to the specification because "the section line label in the Brief Description of Figure 2 should be changed to correspond to the amended section line label." (Office Action at 3.) Applicants have amended the specification in accordance with the Examiner's request. Accordingly, Applicants respectfully request the removal of this objection.

Furthermore, Applicants have amended paragraph [0018] of the specification to capitalize the trademark WECO, in accordance with the Examiner's suggestion.

IV. Remarks Regarding Objections to the Drawings

The Examiner has objected to the drawings because "the labeling of the section line in Figure 2 is not in the proper format; all section lines must be labeled with Roman or Arabic numerals." (Office Action at 2.)

In response to this objection, Applicants have submitted herewith a Replacement Sheet for Figure 2, in which Applicants have made the corrections requested by the Examiner. Accordingly, Applicants respectfully request the withdrawal of the objections to the drawings.

V. Remarks Regarding Rejection of Claims 1, 2, 4, 5, 7, 9, 10, 12, 13, 16-18, 20, 21, 23-25, 27, 30, 33, and 34 Under 35 U.S.C. § 102(b) as Anticipated By U.S. Patent No. 1,935,027 issued to Heggem *et al.* (hereinafter, “Heggem”).

The Examiner has rejected claims 1, 2, 4, 5, 7, 9, 10, 12, 13, 16-18, 20, 21, 23-25, 27, 30, 33, and 34 under § 102(b) as being anticipated by *Heggem*. Applicants respectfully traverse because *Heggem* does not disclose each and every limitation of claims 1, 2, 4, 5, 7, 9, 10, 12, 13, 16-18, 20, 21, 23-25, 27, 30, 33, and 34 as required to anticipate these claims under 35 U.S.C. § 102(b). See MPEP § 2131.

In particular, *Heggem* fails to disclose “a removable surface pack-off device, comprising: at least one fluid passage disposed within the housing, which is adapted to pass fluid from a location outside of the well into an annulus formed between the inner and outer casings” as recited in independent claims 1, 16, and 33. With respect to independent claims 1, 16, and 33, the Office Action alleges that:

Heggem discloses a removable surface pack-off device that includes the following features: A housing (Figure 1) adapted to be mounted between the ends of an inner casing 11 and an outer casing 10 at the well surface. At least one fluid passage 17 disposed within the housing and being capable of passing fluid from a location outside the well to an annulus between the casings. A first pressure-activated seal 16 disposed between the inner casing and the housing. A second pressure-activated seal 16 disposed between the outer casing and the housing.

(Office Action at 3-4.) Nowhere does *Heggem* disclose this recitation. However, rather than disclosing this recitation, *Heggem* provides that “[p]acking material 31 which is interposed between the packing follower rings 30 is compressed by the latter against the adjacent inner string of casing 12, *thus packing off the space between the innermost string of casing and the next outer string of casing.*” *Heggem*, Col. 4, lines 77-82, emphasis added. Furthermore, *Heggem* provides for “fluid outlet passages 17 . . . for connection with pipes through which the fluid may flow to storage tanks or the like.” *Heggem* Col. 3, lines 10-13, emphasis added. Independent claims 1, 16, and 33 require “at least one fluid passage disposed within the housing which is adapted to pass fluid from a location outside the well into an annulus formed between the inner and outer casings.” However, as noted above in *Heggem*, the space between the innermost string of casing and the next outer string of casing is packed off. Thus, an annulus is not formed between the inner and outer casings through which fluid may pass. Also, the fluid

passages of *Heggem* are “fluid outlet passages,” which are directed to the flow of fluid from a location inside of the well to a location outside of the well. Accordingly, it is clear that *Heggem* does not disclose at least one fluid passage disposed within the housing, which is adapted to pass fluid from a location outside of the well into an annulus formed between the inner and outer casings, as recited in independent claims 1, 16, and 33.

Therefore, independent claims 1, 16, and 33 are not anticipated by *Heggem*. For at least these reasons, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(b) rejection as to independent claims 1, 16, and 33, and their dependents, claims 2-15, 17-32, and 34-36.

VI. Remarks Regarding the Rejection of Claims Under 35 U.S.C. § 103.

A. Claims 6 and 26 Are Not Obvious Over *Heggem* in View of U.S. Patent No. 2,799,476, issued to Bielstein (hereinafter “*Bielstein*”)

The Examiner has rejected claims 6 and 26 under 35 U.S.C. § 103(a) as being unpatentable over *Heggem* in view of *Bielstein*. Applicants respectfully traverse.

To form a basis for a § 103(a) rejection, the suggested combination of prior art references must teach or suggest each and every limitation in the claim. MPEP § 2142 (2004). As discussed above in Section V, *Heggem* does not teach or suggest “a removable surface pack-off device, comprising: at least one fluid passage disposed within the housing, which is adapted to pass fluid from a location outside of the well into an annulus formed between the inner and outer casings” as recited in independent claims 1 and 16, from which the rejected claims depend. *Bielstein* also fails to teach or suggest the recited limitation. Thus, Applicants respectfully assert that the combination of *Heggem* and *Bielstein* fails to form a valid basis for a prima facie case of obviousness as to independent claims 1 and 16 and correspondingly, as to dependent claims 6 and 26. Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C. § 103(a) rejection as to dependent claims 6 and 26.

B. Claims 15, 32, and 36 Are Not Obvious Over *Heggem* in View of U.S. Patent No. 3,965,987 issued to Biffle (hereinafter “*Biffle*”)

The Examiner has rejected claims 15, 32, and 36 under § 103(a) as being unpatentable over *Heggem* in view of *Biffle*. Applicants respectfully traverse.

To form a basis for a § 103(a) rejection, the suggested combination of prior art references must teach or suggest each and every limitation in the claim. MPEP § 2142 (2004). As discussed above in Section V, *Heggem* does not teach or suggest “a removable surface pack-

off device, comprising: at least one fluid passage disposed within the housing, which is adapted to pass fluid from a location outside of the well into an annulus formed between the inner and outer casings” as recited in independent claims 1, 16, and 33, from which the rejected claims depend. *Biffle* also fails to teach or suggest the recited limitation. Thus, Applicants respectfully assert that the combination of *Heggem* and *Biffle* fails to form a valid basis for a prima facie case of obviousness as to independent claims 1, 16, and 33 and correspondingly, as to dependent claims 15, 32, and 36. Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C. § 103(a) rejection as to dependent claims 15, 32, and 36.

VII. Allowable Subject Matter

The Examiner has objected to claims 3, 8, 11, 14, 19, 22, 28, 29, 31, and 35 although he stated that these claims “would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.” (Office Action at 5.) Applicants gratefully acknowledge the Examiner’s indication that these claims would be allowable if rewritten in independent form. However, as Applicants have traversed the Examiner’s rejections of the base claims 1, 16, and 33, Applicants respectfully assert that claims 3, 8, 11, 14, 19, 22, 28, 29, 31, and 35 are allowable in their original form.

VI. No Waiver

All of Applicants’ arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner’s additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art. The example distinction discussed by Applicants is sufficient to overcome the anticipation and obviousness rejections.

SUMMARY

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding objections and rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the

prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe that there are no fees due in association with the filing of this Response. However, should the Commissioner deem that any fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and direct that any additional fees be charged to Baker Botts L.L.P. Deposit Account No. 02-0383, Order Number 063718.0446.

Date: May 8, 2006

Respectfully submitted,



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